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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Michael Adendorff

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EXAMINER

SAINDON, WILLIAM V

ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/675,679	<b>Applicant(s)</b> ADENDORFF ET AL.	
	<b>Examiner</b> WILLIAM V. SAINDON	<b>Art Unit</b> 3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-11, 36 and 39-52 is/are pending in the application.
- 4a) Of the above claim(s) 39-52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-11 and 36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 39-52 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. The following NON-FINAL Office Action is in response to Applicant's submission received July 28, 2008. Claims 1-5, 7-11, and 36 are pending.

### ***Election/Restrictions***

2. Applicant's election of group I in the reply filed on July 28, 2008 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election **without** traverse (MPEP § 818.03(a)).

3. Claims 39-52 are **withdrawn** from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, group II, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on July 28, 2008.

### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. **Claims 1-5 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.** The steps recited do not qualify as a statutory process. In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials).

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Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter.

The claims are directed towards abstract data and therefore cannot transform an object. The claims are not tied to another statutory class because they do not require a particular apparatus (e.g. a particular computer). Therefore, the claims are non-statutory.

6. **Claims 7-11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.** Specifically, the claims are directed to a "system," but no structure is recited.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. **Claims 1-4, 7-10, and 36 are rejected under 35 U.S.C. 102(b) as being barred by prior sale of Cognos Enterprise Business Intelligence Software** (hereinafter Cognos).

**As to claim 1**, Cognos discloses: A method in a computer system for presenting business performance information, the method comprising steps of:

displaying a list of Key Performance Indicators (KPIs) having delta indication scores indicating changes in the KPIs (see e.g. p. 63, noting the scorecarding provides trends);

providing display options (see id., noting scorecard is a display option; p. 66, noting that the scorecard display is "interactive" and therefore has options for display);

receiving selection of a display option (see p. 66; 73 noting various options are selected) ; and

presenting performance information of the KPIs based on the selected display option (see p. 73, noting the display locations with no data is selected).

**As to claim 2**, Cognos discloses that the displaying step displays the KPIs having delta indication scores which are calculated based on new data and historical data of the KPIs to indicate improvement or degradation of KPIs (see p. 63, noting trend data uses new and historical data in this context);

the receiving step receives selection of a display option including a sorting option for sorting KPIs based on the delta indication scores (see p. 29); and

the presenting step presents performance information of the KPIs as sorted according to the sorting option, and/or presents performance information of KPIs as grouped in multiple groups (id.).

**As to claim 3**, Cognos discloses the receiving step receives a display option for filtering KPIs based on multiple types of scores; and the presenting step presents performance information of the KPIs filtered based on multiple types of scores (see p. 29, noting filters).

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**As to claim 4**, Cognos discloses the displaying step displays the KPIs further having variance indication scores which are calculated based on new data and target data of the KPIs to indicate differences from the target data of KPIs (see p. 66, noting variance levels in results are given).

**Claims 7-10** are rejected for similar reasons as claims 1-4.

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. **Claims 5 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cognos in view of Official Notice.**

**As to claim 5**, Cognos discloses the receiving step receives selection of a display option including a filtering and the presenting step presents performance information of the KPIs, as shown above.

Cognos fails to explicitly disclose to filter KPIs based on variance scores and to present the filter. However, the Examiner takes Official Notice that it is old and well known to filter. It would have been obvious to a person having ordinary skill in the art at the time of invention that Cognos' filter would be used on KPI by variance scores in order to identify particularly high variances that would require immediate attention. Because filtering is old and well known in the art, and Cognos already performs both

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filtering and variance, it would be clear that one of ordinary skill in the art would realize he or she could filter the variance scores with predictable results.

**Claim 11** is rejected for similar reasons as claim 5.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Rebecca Reid, "Cognos adds more to Metrics Manager," ComputerWorld Canada, vol. 19, iss. 16 (Aug. 8, 2003), discloses Cognos' metric manager that allows a user to view variances between a value and a target value.
- Marc J. Epstein & Jean-Francois Manzoni, "The balanced scorecard and tableau de bord," Management Accounting, vol. 79, no. 2, p. 28, (Aug. 1997), discloses the well-known balanced scorecard (BSC) and tableau de bord, which display KPIs and their values and trends.
- Phillip Gordon, "Pilot takes balanced scorecard digital," 757 InformationWeek 74 (Oct. 18, 1999), discloses a computerized BSC indicating trends for KPIs as well as alerts.
- Anne J. Jensen, "A Systems Engineering Process for Specifying and Analyzing Organizational Performance Metrics," Spring 2000 dissertation George Mason University, discloses an overview of scorecarding analysis.

12. This Office action has an attached requirement for information under 37 CFR

1.105. **A complete reply to this Office action must include a complete reply to the**

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**attached requirement for information**. The time period for reply to the attached requirement coincides with the time period for reply to this Office action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILLIAM V. SAINDON whose telephone number is (571)270-3026. The examiner can normally be reached on M-F 7:30-5; alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on (571) 272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/wvs/

/Beth V. Boswell/

Supervisory Patent Examiner, Art Unit 3623



***Request for Information under 37 CFR 1.105***

14. Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

15. The Examiner notes that Applicant's assignee, Cognos (IBM) is a market leader in providing Business Intelligence software, including complex software for use with the well-known scorecarding and KPI analysis methods of business intelligence. It is clear from press releases, technical publications, and Cognos' own website that Cognos has been selling software dealing with KPI presentation and analysis for many years, well before the effective filing date of the application.

16. The information is required to identify products and services embodying the disclosed subject matter and identify the properties of similar products and services found in the prior art.

17. In response to this requirement, please provide the names of any products or services that have incorporated the claimed subject matter. Please include (to the most available level of granularity) the highest version number available to the public more than a year before the effective filing date of this application. For example, if XYZ is currently version 4.2, and was at version 3.6 a year before the effective filing date of this application, please list XYZ as version 3.6 because that is the highest version available as of the date just one year before the effective filing date of this application.

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18. In response to this requirement, please state the specific improvements of the subject matter in the claims over the disclosed prior art and indicate the specific elements in the claimed subject matter that provide those improvements. For those claims expressed as means or steps plus function, please provide the specific page and line numbers within the disclosure which describe the claimed structure and acts.

19. In responding to those requirements that require copies of documents, where the document is a bound text or a single article over 50 pages, the requirement may be met by providing copies of those pages that provide the particular subject matter indicated in the requirement, or where such subject matter is not indicated, the subject matter found in applicant's disclosure.

20. The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 CFR 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.

21. The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is

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unknown or cannot be readily obtained may be accepted as a complete reply to the requirement for that item.

22. This requirement is an attachment of the enclosed Office action. **A complete reply to the enclosed Office action must include a complete reply to this requirement.** The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action.

/wvs/

/Beth V. Boswell/

Supervisory Patent Examiner, Art Unit 3623